



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

081468-0306886

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Signature _____

Typed or printed name _____

Application Number

10/719,065

Filed

Nov. 24, 2003

First Named Inventor

Art Unit

2851

Examiner

Kim, Peter B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record. 44482
Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

John P. Darling

Typed or printed name

(703) 770-7745

Telephone number

January 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 081468-0306886
Client Reference: P-0185.030-US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
MULKENS et al.

Confirmation Number: 9148

Application No.: 10/719,065

Group Art Unit: 2851

Filed: November 24, 2003

Examiner: Kim, Peter B.

Title: LITHOGRAPHIC APPARATUS, DEVICE MANUFACTURING METHOD, AND
DEVICE MANUFACTURED THEREBY

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed on this same date, Applicants respectfully request review of: 1) the objection to claim 1, 12, 24, 25, 39, 50, 51, 52, 54 and 55; 2) the objection to claims 12 and 39; 3) the rejection of claims 26, 29, 30, 39, 50, 51 and 56-61 under 35 U.S.C. § 102(e) over Nishi (U.S. Patent 6,545,746); and 4) the rejection of claims 1-62 under the judicially created doctrine of obviousness-type double patenting.

As noted on page 14, lines 10-22, of the response filed August 4, 2005, the examiner provides no basis in either 35 U.S.C., 37 C.F.R., or even the MPEP, for the objection to the claims. The undersigned specifically traversed the baseless objection and requested that the examiner provide a basis, or withdraw the rejection.

As noted on page 13, lines 13-24, although Applicants traversed the objection, and the examiner repeated the objection, the examiner provided no response to Applicants' traversal as required by MPEP § 707.07(f).

In response to the Applicants' attempt to amend around the objection, the examiner issued an Advisory Action denying entry of Applicants' amendments on the grounds that the proposed amendments present new issues that would require further consideration and/or search.

It appears to be the position of the examiner that he can object to Applicants claims without any basis in 35 U.S.C. or 37 C.F.R. It also appears to be the position of the examiner

that he is not required to answer Applicants' traversal of his baseless objection. It even further appears to be the position of the examiner that he is not required to consider Applicants' attempt to amend around his baseless objection.

It is respectfully submitted that the examiner's actions are completely contrary to law and PTO policy. The undersigned respectfully requests that the examiner be required to provide a basis for the objection, or enter the December 12, 2005 response and issue a new Office Action.

With respect to the examiner's objection to claims 12 and 39, as noted on page 13, lines 25-31, of the December 12, 2005 response, the examiner has provided no basis for the objection. As also argued in the December 12, 2005 response, the amendment to claim 12 fully obviates the baseless objection and the baseless objection is simply not commensurate with claim 39 as the claim does not recite an absorbent gas.

It is respectfully requested that the examiner provide a basis for the objection to claims 12 and 39, or enter the December 12, 2005 response and issue a new Office Action.

With respect to the rejection of claims 26, 29, 30, 39, 50, 51 and 56-61 under 35 U.S.C. §102(e) over Nishi (U.S. Patent 6,545,746), as noted on page 14, lines 4-14 of the December 12, 2005 response, claim 29 depends from claim 28, which was not rejected as anticipated by Nishi. Accordingly, claim 29 cannot be anticipated by Nishi. Similarly, claims 56, 57, 60 and 61 depend from claims 24, 25, 54 and 55, which were not rejected as anticipated by Nishi. Therefore, claims 56, 57, 60 and 61 cannot be anticipated by Nishi. As also argued on page 14 of the December 12, 2005 response, although the claims are product-by-process claims, as there is no way to claim that structure other than by the method of its production, the Examiner is required to consider the structure produced by the method. See MPEP § 2113. It is also respectfully submitted that as claims 56, 57, 60 and 61 contain all the limitations of the claims from which they depend, they cannot be anticipated by a prior art reference which the examiner acknowledges does not anticipate the claims from which they depend.

With respect to the Examiners allegation that Nishi discloses a radiation-energy detector and a concentration controlled volume of radiation absorbent gas to be traversed by a beam of radiation, Applicants clearly pointed out the deficiency of this reasoning on page 14, lines 15-32, of the December 12, 2005 response.

As noted in the December 12, 2005 response, independent claims 29 and 50 do not recite absorbent gas. For the independent claims which do recite an absorbent gas,

Applicants also noted that Nishi explicitly states in column 47, lines 33-34, that the helium (He) gas is not excited because it does not absorb the ArF excimer laser light.

As clearly noted by Applicants on page 14, lines 29-31, of the December 12, 2005 response, the self-measuring device 31 of Nishi detects a positional relationship between the pattern on the reticle R and the fiducial pattern on the basis of the image signal in a state where the reticle R and the fiducial mark member FM are stationary, it does not determine the energy of a beam of radiation, it does not comprise a sensor that provides an output signal that is proportional to an amount of interaction of the beam of radiation with a region of gas. The self-measuring device 31 of Nishi simply does not correspond to the claimed radiation-energy detector.

Applicants also clearly noted the deficiency of the Examiner's allegation that the detector of Nishi detects a beam of radiation passing through a region of interactive gas. On page 15, lines 1-8, of the December 12, 2005 response, Applicants clearly noted that claims 26 and 50 do not claim detecting a beam of radiation passing through a region of interactive gas. Claim 26 recites a sensor providing an output signal that is proportional to an amount of interaction of the beam of radiation with the region of gas and claim 50 recites measuring the amount of interaction of the beam of radiation with the interactive gas. There is no element, system, device, apparatus, and/or process disclosed by Nishi that corresponds to these claimed features.

With respect to the rejection of claims 1-62 under the judicially created doctrine of obviousness-type double patenting over claims 1-23 of U.S. Patent 6,538,716 as clearly argued on page 15, line 13 through page 16, line 4, the Examiner has not performed the analysis required for a rejection under the judicially created doctrine of obviousness-type double patenting and has not presented a *prima facie* case.

The examiner acknowledges on page 4, lines 6-11, that U.S. Patent 6,538,716 does not claim a radiation energy detector, but concludes that because U.S. Patent 6,538,716 claims an energy sensor that measures gas composition, that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the radiation energy detector of the application to the claims of 716 in order to properly control radiation."

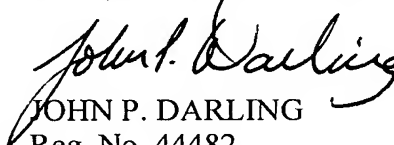
As noted in the December 12, 2005 response, the examiner provides no analysis of the differences between the 62 claims of the application and the 23 claims of U.S. Patent 6,538,716 or any reasons why the differences would have been obvious to one of ordinary skill in the art. As noted on page 15, lines 24-28, of the December 12, 2005 response, the

MULKENS et al. -- 10/719,065
Attorney Docket: 081468-0306886

examiner's mention of one claimed feature of the instant application and his hindsight determination that it would have been obvious to provide the one feature to the claims of U.S. Patent 6,538,716 can hardly present a *prima facie* case of obviousness-type double patenting.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

A handwritten signature in black ink, appearing to read "John P. Darling", is written over the printed name.

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Date: January 17, 2006

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